

REMARKS/ARGUMENTS

Responsive to the Office Action mailed March 28, 2008:

I. NON-PRIOR ART MATTERS

A. The Office Action objected to the Abstract of the disclosure.

An amended Abstract is enclosed herein.

B. The Office Action rejected claims 4 and 9-11 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

An appropriate amendment is enclosed herein.

II. PRIOR ART MATTERS

A. The Office Action rejected claim 1 under 35 USC 102(b) as being anticipated by GB Patent No. 775,174. Applicant respectfully traverses this rejection.

A single prior art reference anticipates a claimed invention only if it discloses each and every claim element.¹ "For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review."² "This standard is very strict. It requires an exact correspondence between the contents of the event and the claim limitations, such that each and every element recited in the claim is present in the anticipatory event."³

The British patent does not disclose the claimed method *characterized in that the step of turning over the mould (1) is preceded by a step of placing a cover plate on the mould (1) and followed by a step of removing the cover plate.*

¹ *Structural Rubber Prod. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984); *Transclean Corp. v. Bridgwood Services, Inc.*, 290 F.3d 1364, 1370, 62 U.S.P.Q.2D (BNA) 1865 (Fed. Cir. 2002).

² *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

³ *Moy's Walker on Patents*, 4th ed., § 8.11 (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D(BNA) 1655 (Fed. Cir. 1990))

The Office Action identifies element 11 of the British patent as the claimed cover plate. The Office Action is incorrect. Element 11 of the British patent is not a cover plate but a circular flat disc that cooperates with the piston 6 to urge the soil block out of the cup 1. Element 11 does not "cover" anything. Furthermore, the British patent does not disclose, as separate steps, placing a cover plate on the mould and removing the cover plate. The drawings of the British patent clearly show that the disc 11 is permanently affixed to the piston 6.

Therefore claim 1 is patentable over the British patent.

B. The Office Action rejected claim 2 under 35 USC 103(a) as being unpatentable over the British patent in view of Beckham.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.⁴ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.⁵

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁶

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

1. The cited prior art does not teach or suggest all the claim limitations.

Claim 2 has additional elements or limitations beyond allowable claim 1 and is also allowable.

⁴MPEP Sec. 2142.

⁵Id.

⁶Id. (emphasis supplied)

- C. The Office Action rejected claims 3 and 5-8 under 35 USC 103(a) as being unpatentable over the British patent as applied to claim 1 above and further in view of JP Patent No. 2-312522.

Claim 3 has additional elements or limitations beyond allowable claim 1 and is also allowable.

Claim 5 has additional elements or limitations beyond allowable claim 1 and is also allowable. Furthermore, neither reference discloses a step following the step of removing a cover plate from the mold after turning over the mold.

Claims 6-8 have additional elements of limitations beyond allowable claim 5 and are also allowable. Further as to claim 7, there is no disclosure in the British patent of removing the piston 6 from the mold.

- D. The Office Action rejected claims 4 and 9-11 under 35 USC 103(a) as being unpatentable over the British patent as applied to claim 1 above and further in view of Beckham.

First, the Office Action's reasoning is defective, because the Office Action states:

Beckham does not disclose placing the plant and clod in the hole in the mound cover. Beckham does disclose placing the plant and clod in the hole in the mound cover – see figures 1 and 4.

The two statements are contradictory.

Claim 4 has additional elements or limitations beyond allowable claim 1 and is also allowable.

Claim 9 has additional elements or limitations beyond allowable claim 8 and is also allowable.

Claims 10-11 have additional elements or limitations beyond allowable claim 1 and are also allowable.

- E. The Office Action has not provided a suggestion or motivation to combine the cited references.

Although evidence of a motivation to combine need not be found in the prior art reference themselves, if it is found in the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved, the Office Action must do more than simply discuss the ways that the multiple prior art references can be combined to read on the claimed invention. Rather, the Office Action must point out “specific information in [the two references] that suggest the combination.”⁷ “The Board [must] explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.”⁸

In *KSR Int'l Co. v. Teleflex Inc. et al.*⁹, the Court re-affirmed that:

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.¹⁰

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.¹¹

There is no evidence or suggestion in any of the cited references of the claimed configuration. *Ex Parte Katoh et al*, Appeal 20071460, Decided May 29, 2007.

There is no suggestion to combine the teachings and suggestions of the cited references, as advanced by the Examiner, except from using Appellants' invention as a template through a hindsight reconstruction of Appellants' claims. *Ex Parte Crawford et al*, Appeal 20062429, Decided May 30, 2007.

⁷ See *Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356,1366, 80 USPQ2d 1641, ___ (Fed. Cir. 2006) (citing *In re Dembiczak*, 175 F.3d 994, 999-1000 (Fed. Cir. 1999)

⁸ *Id.* at 1367 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998))

⁹ *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727. 82 USPQ2d 1385 (2007)

¹⁰ *Id.*

¹¹ *Id.*

- F. The Examiner has not applied the test of *Graham v. John Deere Co.*¹² The MPEP requires the Examiner to do so.¹³ However, the Examiner has made no finding of the level of ordinary skill in the art.¹⁴

The Federal Circuit routinely vacates conclusions of obviousness when the factfinder failed to make *Graham* factor findings.¹⁵ This is especially so when the factfinder makes conclusory statements that “do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”¹⁶

The Supreme Court has re-affirmed this need:

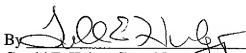
Often, it will be necessary for a court to look to ... the background knowledge possessed by a person of ordinary skill in the art...in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.¹⁷

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

Dated: 27 June 08

By 
Gerald E. Helget (Reg. No. 30,948)
Nelson R. Capes (Reg. No. 37,106)
BRIGGS AND MORGAN, P.A.
2200 IDS Center, 80 South Eighth Street
Minneapolis, MN 55402
Telephone: 612-977-8480
Facsimile: 612-977-8650

¹² 383 U.S. 1 (1966)

¹³ MPEP § 2141

¹⁴ MPEP § 2141.03

¹⁵ *Dystar*, 464 F.3d 1366 and cases cited therein.

¹⁶ *Id.*

¹⁷ KSR, 550 U.S. ____ (2007)